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09/421,108 10/19/99 HSU

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EXAMINER

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PATEL, J

ART UNIT

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2164

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
09/421,108

Applicant(s)  
Hsu et al

Examiner  
Jagdish Patel

Art Unit  
2164



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Oct 19, 1999
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-194 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-194 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 16) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 20) ☐ Other:

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## DETAILED ACTION

### *Claim Rejections - 35 USC § 101*

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 1,3-5, 7, 9-17, 19, 22-32, 33-42, 44-46, 48-54, 56-58, 60- 66, 67-74, 76-78, 80, 82-102, 103, 105-107, 109, 111-134, 136, 138, 139, 143, 145-156, 158, 159, 163, 165-174, 175-179, 182-184 and 186-194 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The claimed invention is a computer related invention. The Computer-Implemented Invention Guidelines issued by the U.S. Patent and Trademark Office describe the procedures for examining such inventions.

The aforementioned claims are rejected because the claimed invention(s) lack practical utility because the claims as a whole do not achieve any practical application within technological art (i.e. produce a concrete, useful and tangible result. Refer to MPEP p. 2100-13 for additional details). The following exemplary analysis is provided for further explanation:

Claim 1: the claimed invention does not produce a concrete, useful and tangible result because it only makes a determination (yes or no) to satisfy the purchase request as recited. Claim 2, on the other hand recites such a practical application (“satisfying the purchase request with the purchase”).

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Similar analysis also applies to all other claims listed above. **The applicant is required to carefully review all claims and make appropriate corrections to conform to the statutory requirements under 35 USC 101 issued by the patent office. (Refer to MPEP chapter 2106 Patentable Subject Matter - Computer-Related Inventions [R-1]).**

All system and apparatus (ex. claims 29-32) are analyzed as their corresponding method claim (ex. Claim 1) are therefore analyzed as nonstatutory inventions under 35 USC 101.

### ***Double Patenting***

3. Applicant is advised that should claims 1-32 and 135-150 be found allowable, claims 103-134 and 155-174 respectively will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 3-4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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Claim 3 and 4 recites “an excess amount from the purchase”. There is no antecedent basis in parent claim 1 because there is no step reciting completion of (satisfying) the purchase nor there is a recitation of determining an excess amount in claim 1.

(The applicant is required to review all claims that contain similar deficiency. Due to large number of claims of the application, the above analysis is provided as only an example).

6. 1-192 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are:

Claims 1-194: no entity or entities identified where the “receiving a purchase request...” and the “determining...” process takes place.

The method claim 4 is deficient in that no clear relationship (link) is established between the entity receiving the purchase order from the giver, the giver and the recipient.

Claim 5: it is vague and unclear how according to claim 5, “excess from the purchase amount ..” is provided as a “partial satisfaction of another purchase request” when “another purchase request” does not exist or is not received prior to the claimed process?

Claims 3-5, 8: claim 3 recites “...refunding an excess from the purchase...” while the purchase is not completed (i.e. not satisfied). Similar deficiency exists for claims 4 and 5.

Claim 8: there is no step reciting receiving a purchase request from multiple givers, thus it not possible to perform the process recited in claim 8.

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Note that the above examples are only exemplary and provided to communicate typical deficiencies in the claimed inventions to the applicant. The applicant is required to review all claims thoroughly for deficiencies similar to those identified above and make necessary corrections.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

8. Claims 1-4, 6, 8-20, 22, 28, 33-49 and 51-65 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by "UCOPIA: Ucopia Unveils New Wedding Registry Partners;...."; Business/lifestyle Editors and Retail/Technology Writers, July 1998 (hereafter referred to as Ucopia)

Claim 1: Ucopia discloses a method comprising:

receiving a purchase request from a giver with an associated purchase amount (this step is inherent in the process purchase of a gift for a recipient, first para.)

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determining whether to satisfy the purchase request with a purchase or a (gift) substitution option (In a gift registry such as Ucopia teaches choices are provided to a giver, see “Ucopia features..” on p. 1 ).

Claim 2: satisfying the purchase request with the purchase (p.1 para. 5 ).

Claim 3: this limitation is inherent in any purchase transaction process because any excess amount from the purchase amount is returned to the purchaser (or giver).

Claim 4: providing an excess from purchase amount (inherent to any purchase transaction)

Claim 6: satisfying the purchase request with the gift substitution option ( a typical gift registry provides a list of vendors and associated list of gift purchase items refer to Weddingchannel.com or weddingnetwork.com as example, this feature is inherent in Ucopia).

Claim 8, 10, 14, 15: satisfying the purchase request with purchase from multiple givers (Ucopia para.7. Other listed claims are similarly analyzed.)

Claim 9: Identities of established vendors (retail network, para. 1).

Claim 11 and 12: collecting a gift idea is inherent (a basic step) to any gift registry (para 1.). As to different methods (in-store, in-locale, kiosk) refer to para. 5.

Claim 13: providing identities of established vendors..(para. 1 “retail network).

Claim 16 and 17: accessing an electronic commerce system...(purchasing online..para. 5).

Claim 18 and 19: notifying a recipient of the purchase request (p. 2 L 3-4).

Claim 20: providing a coupon to a recipient (p.2 L 3-4).

Claim 22: analyzed as in claim 12.

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Claim 28: Gift substitution option includes a cash option (inherent to “contribution to ...charity” para. 7).

Claims 33-36, 42, 43: the Ucopia article teaches a well known method of purchasing wherein more than one purchase giver designate a purchase request with an associated amount (group purchases) (refer to para. 7). The claimed limitations are basic steps to such group purchases for example purchases where givers collectively contribute towards gifts that might otherwise be beyond their individual budgets. The claims limitations are well known and inherent to the group purchase method discloses by the Ucopia article.

Claims 63-65 are analyzed as in corresponding method claim 33.

Claims 37-41: analyzed as in claims 24-28 respectively.

Claims 44-49: analyzed as in claims 3-8 respectively.

Claims 51 and 52: analyzed in a similar manner as claim 51 and 52.

Claims 53--62 are analyzed as in claims 12-18, 20-22 respectively.

9. Claims 135-154 and 175-190 are rejected under 35 U.S.C. 102(e) as being clearly anticipated over Cohen “Going to the Chapel. (Wedding channel, wedding Network, American Bridal registry online bridal registries);....”; PC Magazine, v17, n12, 040(1), June 1998) .

Cohen article inherently discloses all limitations recited in claims 135-137. Through reference of web site **weddingchannel.com**, it recites the “receiving a gift purchase request...” and “providing the gift purchase request to a vendor...” steps (refer to the web site for details).



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Claim 136: The offer amount is equal to the gift purchase amount since the giver decides to purchase a listed gift in the amount specified.

Claim 137: identifying the vendor...previous gift requests (items requested and items still needed)

Claims 138, 139: inherent because the gift registry is online via e-commerce application.

Claims 140-150 are inherent in the cited reference or have been analyzed in previous claims.

Claims 151-154 are analyzed as corresponding method claim 135.

10. Regarding claims 175-190: limitations recited are well known and obvious required/desirable steps for operation of a gift registry as shown in a typical gift registry such as [www.weddingnetwork.com](http://www.weddingnetwork.com). For example per claim 175, web site **weddingchannel.com** as previously referenced discloses steps of claim 175 as follows:

receiving gift idea from a recipient (items requested);

receiving a gift amount which is determined by the recipient and associated with the gift idea (price).

All dependent claims are either inherent to the reference and/or previously discussed in analysis of other dependent claims.

Claims 191-194 are analyzed as in method claim 175.

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***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 5-7, 9, 11-13, 17, 21, 23 and 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ucopia.

Claims 5-7: (not explicitly recited in Ucopia ) claimed limitations are well known variations of a purchase transaction. For example, it is well known that a merchant returns excess amount as a change to the giver (a customer) or that the excess from the purchase amount is applied to another purchase request (excess may be offered in the form a voucher for future purchase of a different product, a gift certificate or cash). One would be motivated to implement these features in Ucopia to provide customers convenience of shopping and improving merchant's goodwill towards the customer.

Claim 9 and 50: it is old and well known in the e-commerce to provide identities of multiple vendors to a customer, for example **bargainfinder.com** or such other online web sites which provide identities of established ...(vendors to the giver) which assist the giver with the purchase request.

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Claim 11, 12: it is old and well known to collect a gift idea from a recipient as claimed (example, gift registries (refer to cited reference of VEENEMAN et al) which assist the gift purchasing by the givers for example at well known dept. stores gift registries.

Claim 13: it is old and well known to identify vendors (a plurality of retail establishments ) of gift items to the recipients in any gift registry because it helps the recipients with the selection of broad range of desirable brand gift ideas.

Claim 17: inherent to any transaction involving a purchase as discussed in claim 1 analysis.

Claim 21: it is old and well known practice to provide a receipt to the purchaser in the form of a receipt, a voucher or another form of confirmation which serves as a memo to the giver.

Claim 23: it is old and well known in a purchase transaction to compare a purchase amount (money presented to satisfy completion of the purchase request) to a price of goods so that correct purchase price is paid by a purchaser complete the purchase.

13. Claims 24-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ucopia and further in view of Cohen (PC Magazine, v 17, n12, p40(1), June 1998).

Claims 24-27: Ucopia reference fails to disclose the relationship and connectivity features recited in claims 24-27. However, Cohen teaches a gift registry (www.abregistry.com), p.1 para. 4) having the claimed features of using a plurality of vendors. It would have been obvious to incorporate said plurality of vendors and providing the purchase request to the vendors in order that a giver can access wide selection of vendors for most appropriate purchase.

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14. Claims 67-102 are rejected under 35 U.S.C. 103 as being obvious over Cohen "Going to the Chapel. (Wedding channel, wedding Network, American Bridal registry online bridal registries);...."; PC Magazine, v17, n12, 040(1), June 1998) and further in view of the UCOPIA reference.

Cohen reference with the content of the disclosed web sites teaches the method as recited in claim 67 including receiving gift idea with an associated gift amount from a gift recipient (gift ideas are "items requested" receiving commitment to a purchase request is shown as "still needed" (refer to web page **weddingchannel.com** referenced in the article.).

Cohen through **weddingchannel.com** does not teach a feature of second giver. However, this feature is taught in the UCOPIA reference as discussed above. A motivation to provide a feature of receiving a purchase request from more than one giver is also discussed above in analysis of claim 33.

Dependent claims 68-98 of parent claim 67 have been analyzed as in dependent claims previously analyzed. For example, claims 68-71 have been analyzed as a method of group purchase of a gift.

Claims 99-102 have been analyzed as in corresponding method claim 67.

#### ***Prior Art Cited***

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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*Conclusion*

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jagdish Patel whose telephone number is (703) 308-7837. The examiner can normally be reached Monday-Thursday from 8:00 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin, can be reached at (703) 308-1065.

The fax number for Formal or Official faxes to Technology Center 2700 is (703) 308-9051 or 9052. Draft or Informal faxes for this Art Unit can be submitted to (703) 308-5397.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

JNP 04/26/01

  
VINCENT MILLIN  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100